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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,300	05/23/2001	Chandrasekar Venkatraman	10960787-11	2270

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80528-9599

EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,300

Applicant(s)

VENKATRAMAN ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-115 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 33-115 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 33-115 are presented for examination.
2. In view of the Terminal Disclaimers, all United States Applications should be mentioned in the related section of the specification including their status (i.e., those mentioned in the Double Patenting rejection outlined in examiner's prior action).
3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

4. The following is a quotation of the first paragraph of 35 U.S.C 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C 112, first paragraph, as failing to adequately teach how to make and/or use the invention, i.e. failing to provide an enabling disclosure for the reasons indicated infra.
6. The grounds for objecting to specification as presented in examiner's prior action continue and are hereby incorporated in this Office Action by reference including thereto with the additional remarks indicated below.
7. Claims 33-115 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification. This rejection was presented in examiner's prior action which continues and is hereby incorporated in this Office Action by reference including thereto with the additional remarks indicated below.
8. It should be clearly noted the objections and rejections under 35 U.S.C. 112, first paragraph, indicated herein, are under "enablement" requirement and not "written description" requirement. There is/are no ground(s) and rejection(s) under "written description" requirement. The enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the description requirement. However, where there is a lack of enablement, if the written disclosure is of sufficient breath, such disclosure may satisfy the enablement requirement. In other words, detailed procedures for making and using

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the invention may not be necessary if the description of the invention itself is of sufficient depth to permit those skilled in the art to make and use the invention.(see MPEP 2164 et seq.). Such a description is lacking within this application and thus too fails to also satisfy the enablement requirement of 35 U.S.C. 112, first paragraph. Hence, there is a lack of the enablement requirement and the description, as an alternative backup, fails to resolve the matter of the enablement requirement.

9. The applicant responded to the objection and rejection, under 35 U.S.C. 112, first paragraph, by arguing in substance that examiner has not cited any language in the claims other than to each of the devices claimed therein. However, examiner's prior Office Action clearly indicated the language of the claims within the Office Action after the quotation of 35 U.S.C. 112, first paragraph. Specifically, each of the claims contain language which enable control functions of the claimed device; but, there is a lack of the enablement requirement, called for by 35 U.S.C. 112, first paragraph, of the device specific control functions for the specific claimed device (i.e., device specific software and/or hardware that is the control function(s) for the specific claimed device). As indicated in examiner's prior action, the only mention in the specification of the claimed control functions used to control each claimed device is generically described on page 9 (line 14), page 12 (lines 10-15), and page 22 (lines 6-15) of the specification leaving those skilled in the art to write the software and/or firmware that is the claimed control functions. This description, and argued others, of the claimed "***enabling control functions***", is inadequate to fill the void of the enablement requirement which is lacking in this application. The applicant has failed to disclose how to make and/or use the "control functions" and/or the monitor coupled to the web server, wherein the monitor ***controls*** device-specific functions of the copier.

10. Claims 33-115 of this application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No 5,956,487 and/or claims 1-32 or U.S. Patent 6, 170,007. Although the conflicting claims are not word for word identical, they are not patentably distinct from each other because of the reasons outline in examiner's prior action. No Terminal Disclaimer has been filed as so argued in the applicant's October 1, 2004 response on page 21 (second to last paragraph) nor do amendments to the claims overcome this rejection which continues and is hereby incorporated from examiner's prior action into this action.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a)

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shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

12. Claims 33-115 are rejected under 35 U.S.C. 102(e) as being anticipated by Martenson (U.S. 6,219,708 B1).

13. The grounds for rejecting the claims, and rejection, under 35 U.S.C. 102(e), as presented in examiner's prior action, continue and are hereby incorporated into this Office Action by reference.

14. The applicant argued, the grounds and rejection under 35 U.S.C. 102(e), in substance, by stating, in general, that Martenson does not disclose a mechanism embedded in a device that generates a web page for the device as claimed. However, col. 8 (lines 41-et seq) and col. 10 (lines 46-et seq.), and specifically col. 9 (lines 5-43) (as examples) clearly taught an embedded web access mechanism within a device having an embedded web server that generated device web pages (HTML documents also called HTML pages as shown in col. 9 (lines 5-43) (as an example) which are then returned to a user's browser such that the user can view the web pages (HTML document(s), HTML page(s), or web page(s)) to selectively control the device. Hence, Martenson did disclose a mechanism embedded in a device that generated a web page for the device as claimed. That is, Martenson's embedded web server generated web pages per the example in col. 9 (lines 5-43).

15. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

17. Claims 33-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martenson (U.S. 6,219,708 B1) in view of Joao (5,917,405).

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18. The grounds for rejecting the claims, and rejection, under 35 U.S.C. 103(a), as presented in examiner's prior action, continue and are hereby incorporated into this Office Action by reference.

19. The applicant argued, the grounds and rejection under 35 U.S.C. 103(a), in substance, by stating, in general, that Martenson and Joao do not disclose or suggest a mechanism embedded in a device that generates a web page for the device as claimed. However, col. 8 (lines 41-et seq.), col. 10 (lines 46-et seq.), and specifically col. 9 (lines 5-43) (as examples) clearly taught an embedded web access mechanism of a device having an embedded web server that generated device web pages (HTML document(s), HTML page(s), web page(s)) which are then returned to a user's browser such that the user can view the web pages (HTML document(s)) to selectively control the functions of the device. Hence, Martenson taught a mechanism in a device that included a web server that generated a web page as claimed. That is, Martenson's embedded web server generated web pages for a user to implement to control the functions of a device per the example in col. 9 (lines 5-43). As for Joao, such provided a list of device types called for by Martenson. The reasons for combining these two references were addressed in examiner's prior action, which reasons continue herein this Office Action but not addressed by the applicant. Hence it was Martenson who disclosed a mechanism embedded in a device that generates a web page for the device as claimed as indicated above and in examiner's prior action which continues and is hereby incorporated in this action by reference.

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

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24. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142